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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,555	03/28/2000	Julious L. Willett	0209-00003	5642

7590 07/21/2004

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EXAMINER


RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/536,555	<b>Applicant(s)</b> WILLETT ET AL.	
	<b>Examiner</b> Umakant K. Rajguru	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. An amendment and a terminal disclaimer have been filed on April 30, 2004.
2. Claims under examination are 1-13 and 41.
3. Rejection of above claims (under the judicially created doctrine of obviousness type double patenting) as being unpatentable over claims 1-13 of US 6,191,196 set forth in earlier Office action is now withdrawn in view of submission of the proper terminal disclaimer.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al (US 5,720,803).

Itoh discloses a composition containing cellulose ester and an article made therefrom (abstract). An aliphatic polyester is an ingredient of the composition (column 5, lines 66-67). An adipic polyester is a suitable polyester (column 6, lines 41-56). Several suitable and conventional additives can be added (column 8, lines 34-37). A mixture of cellulose esters can also be used (column 3, lines 510). It is seen then that while one cellulose ester reads on second component of instant claim 1, other cellulose ester reads on third component of instant claim 1.

Hence, it would be obvious to follow teachings of Itoh and arrive at claimed invention.

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6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al (US 5,720,803) as applied to claim 1 above, and further in view of Xu et al (US 5,821,286).

Itoh does not mention starch as an ingredient of the composition.

Xu discloses compositions containing polyester and natural polymer. The natural polymer is starch (abstract; column 7, line 35 to column 8, line 27).

Hence, it would have been obvious to use starch as an ingredient in the composition of Itoh, to produce a biodegradable, yet cheap, environmentally friendly and moisture resistant composition which can be further used to produce molded products with good dimensional stability.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Itoh et al (US 5,720,803).

Disclosure of Itoh, set forth earlier in item 5, proves that above claim1 lacks novelty.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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*WR* 10. Claims <sup>4, 5 and 9</sup> ~~1-9~~ are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite in failing to conform to the proper Markush terminology.

Proper wording is "one selected from a group consisting of".

Similar is the case with claim 9.

*WR* ~~11~~ Claim 4 recites the limitation "wherein the hydroxyl functional polymer" ~~is~~ on line 2. There is insufficient antecedent basis for this limitation in the claim.

*WR* ~~12~~ <sup>11</sup> Claims 1 and 41 are objected to because of the following informalities:

Word "comprising" is missing after "composition" in line 1 in both claims.

Appropriate correction is required.

Also colon and semicolons at the end of lines need to be deleted.

*WR* ~~13~~ <sup>12</sup> Any inquiry concerning this communication from the examiner should be directed to U.K. Rajguru whose telephone number is (571) 272-1077. The examiner can generally be reached on Monday-Friday 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



U.K. Rajguru/dh  
June 30, 2004



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700